



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/535,268 | 03/21/2006 | Keiji Kubo | 08279.1210USWO | 3871 |
| 52835 | 7590 | 04/01/2009 | EXAMINER | |
| HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902 | | | MCDOWELL, BRIAN E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1624 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 04/01/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/535,268 | KUBO ET AL. | |
| | Examiner | Art Unit | |
| | BRIAN McDOWELL | 1624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 2/12/2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,5,6,9-11,13,15-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 1,5,6,9-11,13,15-18 and 21-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) 20 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

/BEM/

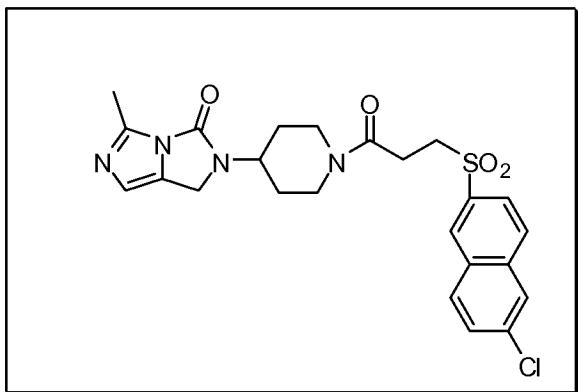
DETAILED ACTION

Status of Claims

Claims 1, 5, 6, 9-11, 13, 15-18, and 20-25 are pending in the application.

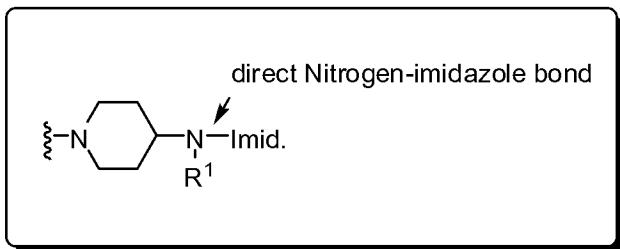
Status of Restriction and Election of Species

In the office action mailed 11/12/2008, the examiner inadvertently stated that the claims under examination were claims 1-25 and 33-37 (Group I). However, in the restriction requirement mailed 9/3/2008, Group I was stated to be drawn to claims 1 and 3-25. The examiner further required an election of species. The elected specie is the following compound below (see example 68 of specification):



The elected specie (2-(1-{[6-chloro-2-naphthyl]sulfonyl}propanoyl)-4-piperidinyl)-5-methyl-1,2-dihydro-3H-imidazo[1,5-c]imidazol-3-one) currently reads on claim 20 in the instant application.

Applicant is advised to take note of the following:



In instant claim 1, variable Z^2 is NR^1 , where R^1 can form a ring with the imidazole ring. However, *nitrogen is directly attached to the imidazole ring* the way the claims are

Art Unit: 1624

drawn (i.e., there is no linker between the two). Therefore, the specie only reads on claim 20.

Claims 1, 5, 6, 9-11, 13, 15-18, and 21-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

This application contains claims drawn to an invention nonelected with traverse in the reply filed on 10/30/2008. A complete reply to this action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

An action on the merits of claim 20 is contained herein.

Status of Priority

Applicant's submission of the translated foreign priority document, see Remarks, filed 2/12/2009, with respect to the Non-Final Office Action mailed 11/12/2008, has been fully considered. Thus, the foreign priority date of the present application is 11/22/2002.

Status of Specification

Applicant's amendment of the abstract, see Remarks, filed 2/12/2009, with respect to the objection set forth in the Non-Final Office Action mailed 11/12/2008, has been fully considered and the objection has been overcome.

Status of Claim Objections

Applicant's amendments of claims 22-25 and 34-37, see Remarks, filed 2/12/2009, with respect to the objection set forth in the Non-Final Office Action mailed 11/12/2008, have been fully considered but are moot since the aforementioned claims are withdrawn from consideration (see restriction and election of specie requirement above) or have been cancelled.

Applicant's amendment of claim 20, see Remarks, filed 2/12/2009, with respect to the objection set forth in the Non-Final Office Action mailed 11/12/2008, has been fully considered and the objection has been overcome.

Status of Rejections

35 USC § 103

Applicant's arguments of claims 1-3,5-9,11,19,21-25, and 33-37, see Remarks, filed 2/12/2009, with respect to the rejection set forth in the Non-Final Office Action mailed 11/12/2008, have been fully considered but are moot since the aforementioned claims are withdrawn from consideration (see restriction and election of species requirement above) or have been cancelled. The rejection has been withdrawn.

35 USC § 112

Applicant's arguments of claims 2 and 33-37, see Remarks, filed 2/12/2009, with respect to the rejection set forth in the Non-Final Office Action mailed 11/12/2008, have been fully considered but are moot since the aforementioned claims have been cancelled. The rejection has been withdrawn.

New Objections and Rejections

Specification

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

It is recommended that the structure of Formula I or the text of the abstract be amended to appropriately embrace the allowable species of the invention.

Claim Objections

Claim 20 is objected to because of the following informality:

On page 8, line 10, there should not be an extra space between the comma and 2 in "-1, 2-dihydro". It should more appropriately read "-1,2-dihydro". Appropriate correction is required.

Conclusion

No claims are allowed.

This application is in condition for allowance except for the following formal matters:

This application contains claims drawn to a non-elected invention and minor informalities. Appropriate action is required.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN McDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone

Art Unit: 1624

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. M./

Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**